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Customer No.: 31561
Application No.: 10/711,534
Docket No.: 13708-US-PAREMARKSPresent Status of the Application

Claim 3 and the disclosure have been respectively objected to because of certain informalities, and appropriate correction is required.

Claims 1-16 and 19 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards the prior art rejections, claims 1-2, 4-5, 9, 11, and 17-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Motoyoshi (USPN 4,218,522; hereinafter "Motoyoshi"). Claims 3 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Frantz et al. (USPN 5,980,309; hereinafter "Frantz"). Claims 7 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Wever et al. (USPN 5,805,423; hereinafter "Wever"). Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Wever as applied to claim 7 above, and further in view of Palmer et al. (USPN 5,851,691; hereinafter "Palmer"). Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Frantz as applied to claim 12 above, and further in view of Wever. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Yasuda et al. (USPN 4,501,805; hereinafter "Yasuda"). Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Frantz and Wever as applied to claim 13 above, and further in view of Yasuda.

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On the other hand, claim 10 would be allowable given that the rejection of claim 10 under 35 U.S.C. 112, 2nd paragraph is overcome and all of the limitations of the base claim and any intervening claims are incorporated therein. Claims 15 and 16 are deemed confusing, such that an evaluation of their subject matter has been precluded by the Examiner.

Applicant has carefully considered this Office action and certain amendments to the specification and to claims have been made to overcome all the objections and rejections. The present amendments are submitted for the purpose of rectifying deficiencies therein and distinguishing the present invention from the prior art, and no new matter issue is raised thereby.

Upon entry of the currently presented amendment, claims 1-18 and 20 remain pending in this application. Reconsideration of the rejections, in light of the foregoing amendments and present remarks, is respectfully solicited.

Discussion of Objections

Claim 3 and the disclosure have been respectively objected to because of certain informalities, and appropriate correction is required.

In response thereto, Applicant has amended the term "a feet" in claim 3 to "a foot" as instructed by the Examiner. The incorrect notation of the anode being positive and the cathode being negative has also been corrected by amending the term "anode" to "positive electrode" and amending the term "cathode" to "negative electrode".

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Discussion of Claim Rejections under 35 U.S.C. 112, 2nd paragraph

Claims 1-16 and 19 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 would be allowable given that the rejection of claim 10 under 35 U.S.C. 112, 2nd paragraph is overcome and all of the limitations of the base claim and any intervening claims are incorporated therein. Claims 15 and 16 are deemed confusing, such that an evaluation of their subject matter is precluded.

After entry of the proposed amendments, the informalities recited in claims 1-16 and 19 have all been removed, and more specifically, claim 15 now depends upon claim 11 to allow the subject matter therein and in claim 16 depending upon claim 15 to stand out for further prosecution. Reconsideration of the rejections is respectfully urged.

Discussion of Claim Rejections

Claims 1-2, 4-5, 9, 11, and 17-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Motoyoshi. Claims 3 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Frantz. Claims 7 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Wever. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Wever as applied to claim 7 above, and further in view of Palmer. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Frantz as applied to claim 12 above, and further in view of Wever. Claim 6 is rejected under 35 U.S.C.

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103(a) as being unpatentable over Motoyoshi in view of Yasuda. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyoshi in view of Frantz and Wever as applied to claim 13 above, and further in view of Yasuda. Applicant respectfully traverses the rejections based on at least the reasons expounded hereinafter.

With regard to claim 1 of the instant application, as current amended, it recites,

"A battery holder mounting a battery to a printed circuit board having a positive contact and a negative contact, the battery holder comprising:

a resilient electrode plate disposed on the printed circuit board and electrically connected to the positive contact, wherein the battery has a positive electrode electrically connected to the resilient electrode plate;

a ring surrounding the resilient electrode plate, accommodating the battery therein and electrically connected to the negative contact of the printed circuit board; and

a battery cap fastened to and electrically connecting with the ring, the battery cap covering a top of the ring, the battery having a negative electrode electrically connected with the battery cap having a step fittingly covering a step of the negative electrode of the battery." (Emphasis added)

As conceded by the Examiner on page 6 of the outstanding Office action, the feature "the step on the battery cap fittingly covers a step on the cathode (being corrected into "negative electrode") of the battery" recited in claim 10 of the current invention is not taught by the prior art of record, and thus claim 10 should be allowable. Applicant thus respectfully amends independent claims 1, 9 and 17 by encompassing said limitation thereto, so as to render the claims 1, 9 and 17 novel, non-obvious and patentable over Motoyoshi.

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Because independent claims 1, 9 and 17 are allowable over the prior art of record, their respective dependent claims 2-8, 11-16, 18 and 20 are allowable as a matter of law, for at least the reason that these dependent claims contain all features/elements/steps of their independent claims 1, 9, and 17. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Applicant further disagrees on the Examiner's assertion regarding the rejection of claim 6 and claims 7-8 depending thereupon, for the aforesaid allowable feature "the step on the battery cap fittingly covers a step on the negative electrode of the battery" recited in claim 10 has also been provided in claim 6 of the present invention, and thus the grounds of rejection of claim 6 as well as claims 7-8 depending thereupon are contradictory to the reason of allowing claim 10 of the present invention. Withdrawal of the deficient and inappropriate rejections is respectfully solicited.

Likewise, inasmuch as the feature "the step on the battery cap fittingly covers a step on the negative electrode of the battery" recited in claim 10 has been considered novel and non-obvious over the prior art of record by the Examiner, claims 11-16 depending upon the patentably distinct claim 10 should also be novel and non-obvious over the prior art of record.

In light of the foregoing, Motoyoshi neither teaches nor suggests the feature "the step on the battery cap fittingly covers a step on the negative electrode of the battery" whose patentability has been affirmed by the Examiner. Hence, said difference between Motoyoshi and the present invention would preclude the factual determination that Motoyoshi identically describes the claimed invention within the meaning of 35 U.S.C. 102, or, in the alternative, within the meaning of 35 U.S.C. 103(a). Hence, the rejections of claims 1, 9, 17 and claims 2-8, 11-16, 18 and 20 depending thereupon are

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not legally viable. The Examiner is accordingly requested to reconsider and withdraw the rejections.

Allowable Subject Matter

Claim 10 would be allowable given that the rejection of claim 10 under 35 U.S.C. 112, 2nd paragraph is overcome and all of the limitations of the base claim and any intervening claims are incorporated therein.

Upon the amendments furnished hereinbefore, the 112 rejection of claim 10 has been overcome, placing Applicant's claim 10 in proper condition for allowance.

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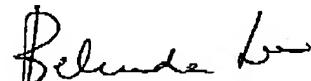
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CONCLUSION

For at least the foregoing reasons, Applicant strenuously urges that the pending claims 1-18 and 20 patentably distinguish over the cited references of record, and requests that the rejections thereof be withdrawn and that the pending claims be promptly allowed. If in considering this response it is believed that a discussion with Applicant's attorney could prove helpful in resolving any additional issues in connection with this application, the Examiner is encouraged to telephone the undersigned at the number indicated.

Date: *Dec. 25, 2007*

Respectfully submitted,


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